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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,078	09/11/2000	John K. Smith	498-239	6232

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EXAMINER

ODLAND, KATHRYN P

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/660,078	Applicant(s) SMITH, JOHN K.	
	Examiner Kathryn Odland	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 12-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment dated March 8, 2004. Claims 1-27 are pending. Given the amendment, the claims are <sup>NOW</sup> viewed in a narrower manner. Thus, the following restriction applies. The abstract of the disclosure was objected to in the previous office action. It does not appear that this objection has been addressed. Thus, it is reiterated below. The amendments to the drawings are acknowledged and accepted.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to an endovascular prosthesis having a patch, classified in class 606, subclass 215.
- II. Claims 12-14 and 18-22, drawn to a multi-component prosthesis, classified in class 623, subclass 1.15.
- III. Claims 15-17 and 23-27, drawn to a bifurcated prosthesis, classified in class 623, subclass 1.35.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and (II and/or III) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are a patch for repair and a connection of devices.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group (II and/or III), restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Christina Warrick on April 15, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

**The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**

Terms such as "disclosed" and "comprising" should be avoided in the abstract

***Response to Arguments***

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed March 8, 2004 have been fully considered but they are not persuasive.

Applicant's arguments have been carefully reviewed; however, applicant is reminded that the preamble does not hold patentable weight when not amplified in the body of the claim. Thus, the preamble recitation, "repairing a damaged area of an endovascular prosthesis" does not serve to distinguish over the prior art. Moreover, applicant's arguments recite, "Neither of the filaments as provided by Strecker operates individually as an endovascular prosthesis." However, the examiner did not directly correlate the filaments to the prosthesis. Further, applicant has not claimed a "prosthesis;" rather applicant claimed an endovascular member. Thus, given a reasonably broad interpretation, the portion that contains one of a hook or loop structure is considered the endovascular member and the portion containing the other of the hook or loop structure is considered the patch, where the patch is attached to the endovascular member as spiraled. Applicant has not claimed any particular structure for the endovascular member that precludes it from being that demonstrated by Strecker. Applicant has failed to claim structural features in order to define over that disclosed by Strecker.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Seid in US Patent No. 5,254,133.

Regarding claim 1, Seid discloses an endovascular prosthesis (such as 66) having an endovascular member having a tubular structure, as seen in figure 13 and discussed as being pushed off from a deployment tube. Further, Seid discloses the tubular structure having one of a hook structure and a loop structure (68) and a patch (such as 62) for placement against the endovascular member, the patch having the other of the hook structure and the loop structure (70), wherein the hook structure and the loop structure are matingly engageable so as to maintain the patch in substantially fluid tight engagement with the endovascular member, as recited in column 8 and seen in figures 6-13.

Regarding claim 2, Seid discloses that as applied to claim 1, as well as, an endovascular member that is selected from the group of grafts, stents and stent-grafts, wherein element (66) can broadly be considered a stent.

Regarding claim 3, Seid discloses that as applied to claim 1, as well as, hook and loop structures that are of textile materials, as recited in column 8.

Regarding claim 4, Seid discloses that as applied to claim 1, as well as, hook and loop structures that are selected from the group of polypropylene terephthalate,

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polyurethane, a copolyester elastomer and nylon, as recited in column 8, encompassed by Velcro®.

10. Claims 5-11 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Strecker in US Patent No. 6,485,524.

Regarding claim 5, Strecker discloses a method of connecting via attaching a patch (via the spiraling connection, etc. where the patch is considered that with one of the hook or loop material), to an endovascular member (is that portion with the other of the hook or loop material), wherein the patch has a hook or loop structure cooperative with a hook or loop structure of the endovascular member for maintaining the patch in substantially fluid tight communication with the endovascular member, as recited in column 7, lines 20-30, column 14, column 15 and seen in figures 1-21.

Regarding claim 6, Strecker discloses that as applied to claim 5, as well as, delivering the patch (such as spiraling the connection) to the endovascular member through a body lumen containing the endovascular member, as recited in column 7, lines 20-30, column 14, column 15 and seen in figures 1-21.

Regarding claim 7, Strecker discloses that as applied to claim 5, as well as, a patch has is one of a hook structure and a loop structure and an endovascular member that has the other of the hook structure and the loop structure, as recited in column 7, lines 20-30.

Regarding claim 8, Strecker discloses that as applied to claim 5, as well as, attaching that is done in situ, as recited in columns 14-18.

Regarding claim 9, Strecker discloses that as applied to claim 5, as well as, attaching that is effective by expanding a balloon affixed to a catheter to cause the hook or loop structure to engage the other of the hook or loop structure of the endovascular member, as recited in column 15, lines 15-20.

Regarding claims 10 and 11, Strecker discloses that as applied to claim 6, as well as, a delivery step that is effected by use of a (balloon) catheter, as recited in column 15, lines 15-20.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

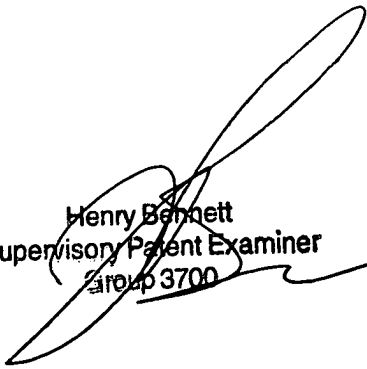
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



Henry Bennett  
Supervisory Patent Examiner  
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